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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,602	03/31/2004	Adriano M.P. Ferreira	69344-A CCD	9675
7590 Christopher C. Dunham c/o Cooper & Dunham LLP 1185 Ave. of the Americas New York, NY 10036			EXAMINER MORILLO, JANEL COMBS	
			ART UNIT 1793	PAPER NUMBER
			MAIL DATE 02/13/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/815,602

Applicant(s)

FERREIRA ET AL.

Examiner

Janelle Morillo

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/31/2007 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashiguchi et al (US 5,486,243) in view of "ASM Desk Editions" p1.

Hashiguchi teaches an Al-Mg alloy comprising (in wt%): 3-10% Mg, a total of 0.3-2.0% Fe + Si, opt. 0.02-0.5% ea at least one of Cu, Mn, Cr, Zr, Ti (column 2 lines 19-25), which overlaps the instant ranges of Mg, Fe, Si, Cu, Mn, Cr, Ti (cl. 9, 12, 13). Hashiguchi teaches a Fe/Si ratio of typically 1-2 (see Table 1).

Hashiguchi does not mention forming said Al-Mg alloy into can ends. However, Hashiguchi does teach forming said alloy into sheet suitable for automobile body sheet and making household electric appliances, said sheet having excellent strength, weldability, and

formability (column 1 lines 8-9). Further, it would have been obvious to one of ordinary skill in the art to form the 5xxx series Al-Mg-Fe-Si-Mn alloy with excellent formability and strength taught by Hashiguchi into can ends, because “ASM Desk Editions” teaches that similar 5xxx series alloys are used for packaging food and beverages, and that “Aluminum alloys of the 3xxx and 5xxx groups are resistant to most foods and beverages” (“ASM Desk Editions” p 1).

Overlapping ranges have been held to be a prima facie case of obviousness, see MPEP § 2144.05. It would have been obvious to one of ordinary skill in the art to select any portion of the range, including the claimed range, from the broader range disclosed in the prior art, because the prior art finds that said composition in the entire disclosed range has a suitable utility. Additionally, “The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages,” In re Peterson, 65 USPQ2d at 1379 (CAFC 2003).

Response to Amendment/Arguments

4. In the response filed on December 31, 2007 applicant submitted various arguments traversing the rejections of record, as well as a 1.132 declaration.
5. The declaration under 37 CFR 1.132 filed December 31, 2007 is insufficient to overcome the rejection of claims 9-13 based upon Hashiguchi and “ASM Desk Editions” as set forth in the last Office action because: declarant states “no-one was able to produce can ends having the required physical characteristics with Fe and Si levels above the stated limits” (i.e. within the claimed values), however, applicant has not shown that the specific prior art of Hashiguchi

would not be suitable for said can end. Nor has applicant shown specific unexpected results or criticality of the presently claimed alloying ranges or Fe/Si ratio (MPEP 716.02 d).

An affidavit or declaration under 37 CFR 1.132 must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In *re* Burekel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979), see also MPEP 716.02(e). "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference, bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference." In *re* Merchant, 575 F.2d 865, 868, 197 USPQ 785, 787 (CCPA 1978) (emphasis in original). Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained, In *re* Finley, 174 F.2d 130, 81 USPQ 383 (CCPA 1949), and if not explained should be noted and evaluated, and if significant, explanation should be required. In *re* Armstrong, 280 F.2d 132, 126 USPQ 281 (CCPA 1960).

6. Applicant's argument that the present invention is allowable over the prior art of record because the prior art of Hashiguchi does not teach or suggest forming can ends from the instant Al-Mg alloy composition has not been found persuasive. As stated in the rejection above, "ASM Desk Editions" teaches that substantially similar 5xxx series alloys are used for packaging food and beverages, and that "Aluminum alloys of the 3xxx and 5xxx groups are resistant to most foods and beverages" ("ASM Desk Editions" p 1).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janelle Morillo whose telephone number is (571) 272-1240. The examiner can normally be reached on 8:30 am- 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art Unit
1742

/J. M./
Examiner, Art Unit 1793
February 8, 2008